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UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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ART UNIT	PAPER NUMBER
3661	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/922,884	MESAROS, GREGORY J.
	Examiner	Art Unit	
	CUONG H. NGUYEN	3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/29/2007 (the Appeal Brief)*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19,43-47 and 57-76* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19,43-47 and 57-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This Office Action the answer to the Appeal Brief filed on 1/29/2007.

2.   Claims 1-19, 43-47, and 57-76 are pending; claims 70-76 are newly added.

Response

3.   Claim 1 has some limitations <u>not positively declared</u>(i.e., "a logistics component that determines a shipping price for the product for a subset of the plurality of buyers, the <u>shipping price being determined</u> at least in part upon the subset of buyers sharing a shipping method." Wherein the subject matter of this claimed invention "shipping price being determined" (e.g., referring to a shipping price Look-Up-Table for $10.0).

Secondly, there should be a modification after "the <u>shipping price being determined</u>"); in current format, "the shipping price being determined at least in part upon the subset of buyers sharing a shipping method" is not a limitation of "system" claim 1.

Thirdly, a claimed format is not conformed: critical components of a claimed system are not comprised, i.e., computer and terminals. etc. – without them, the claim is very broad (see an example of US Pat. 6,269,343 by Pallakoff, wherein the claim's format of a system was conformed.).

In order to present above new grounds of rejection (35 USC 101 and 35 USC 112, 1st and 2nd para., the examiner withdraws a final rejection (mailed in 8/28/2006), and an Advisory Action (mailed in 11/16/2006 and 12/19/2006).

4.   The examiner respectfully submits that the arguments filed on 6/12/2006 are unpersuasive based on what the applicant claims. The examiner interpreted about claimed broad term of "a logistic component" (no further elaboration in pending claims; therefore,

a 35 USC 112, 2nd para. rejection is made) is a formula/calculator (because a Look-Up-Table and a calculator perform this claimed function) – i.e., claim 1 has multiple problems.

Claim Rejections - 35 USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   Claims 1-19, and 70-73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In these claims, all claimed "components" are software instructions (see the specification, page 8, lines 16-30, and page 38 lines 18-20), and these claims recite functional descriptive material, i.e., a computer program per se not clearly embodied on a computer readable medium (see MPEP 2106.01).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6.   Claims 1-19, 43, and 70-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims are rejected because they are vague, indefinite and confusing; since independent claim 1 is directed to a "system", the examiner expects to see structural elements of an apparatus, but all he can see are software components.

Also, in claim 1 "sharing a shipping method" this is unclear because this is also a main subject matter of this invention – in other words, "a shipping method" is not defined

in the context. There is <u>no positive recitation of any structural cooperation among the</u>

<u>element listed</u> (i.e., between "an offers and orders component that receives and

aggregates orders for a product from a plurality of buyers"

and

"a logistics component that determines a shipping price for the product for a

subset of the plurality of buyers, the shipping price being determined at least in part

upon the subset of buyers sharing a shipping method", this rejection as in fact based on

the ground that this claim is incomplete, and therefore, indefinite and in this way does not

conform to the requirement of 35 USC 112)

In independent claim 43, "a computer-implemented logistics component" is vague

– it should be a software module.

Claim Rejections - 35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such **full, clear, concise, and exact terms** as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7.   There is no support for "a logistics component" that claimed in claims 43-47, 57-

69, and 74-76; because this "component" comprises <u>undisclosed software</u>

<u>instructions/codes</u> (see the specification, page 8, lines 16-30, and page 38 lines 18-20),

any person skilled in the art can not make and use the same and carrying out the

inventor's invention without these software instructions.

Claim Objection

8.   In claim 43, "a good" in "...determines a shipping price for a good..." should be

"a goods".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically
disclosed or described as set forth in section 102 of this title, if the
differences between the subject matter sought to be patented and the prior
art are such that the subject matter as a whole would have been obvious at
the time the invention was made to a person having ordinary skill in the
art to which said subject matter pertains. Patentability shall not be
negatived by the manner in which the invention was made.

9.   Claims 1-19, 43-47, and 57-76 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Pallakoff (U.S. Patent No. 6,269,343) in view of Shavit et al. (US Pat.

4,799,156).

A. As to independent claim 1: Pallakoff discloses a system, comprising components to:

-          electronically offering a product for sale (see Pallakoff, Fig. 1 ref. 12a, and

col. 3 line 5 - col. 4 line 36);

-          receiving a first order for the product at a first price (see Pallakoff, col. 3 line

11 - col. 4 line 17);

-          receiving a second order for the product at a second price, the second price

being lower than the first price (see Pallakoff, col. 2 lines 27-28; col. 3 line 11 - col. 4

line 17); then a seller will make a price decision/calculation (that means including a

shipping price (a customer has to pay) for a total cost of each order, see Pallakoff, col.6

lines 14-21, and col.11 lines 44-46).

-       Pallakoff does not expressly disclose about sharing a shipping fee to reduce a cost for the product.

-       However, Shavit et al. (US Pat. 4,799,156) disclose in <u>Detailed Description Text</u> (45) about a suggestion of sharing a shipping cost between involved parties:

"As an additional service, a supplier who has scheduled a shipment of less than a truckload on a particular route, may advertise the available space on the system bulletin board thereby enabling other shippers to share the freight costs. The supplier may limit the type or identity of shippers who may share the route with it utilizing the system 50. Thus, the system 50 can serve as the primary communications link between a supplier and its carriers. Using services available through the system, such as conversational sessions, the alert feature, and mail services provides unique efficiencies in the supplier's freight department.").

The examiner also respectfully submits that a practical example of "delivery lunch" to an office with many different courses for many employees from a Chinese restaurant read-on the claim idea of "different buyers sharing a shipping cost", i.e. a delivery fee for lunch meals that <u>ordered together in a list</u> is different and cheaper than the cost for shipping/delivery from that same restaurant to different individual orders for that lunch.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to combine Pallakoff''s system and Shavitt et al.'s idea to suggests a system to calculate/charge a lower price for customers (including shipping price for that order – usually an order's shipping cost is calculated from weight/size of that order, it is well-known to include many different orders in one package for the advantage of to avoid

standard charges for separate orders; especially many employees of the same office order different products in a list from that same office) - note that this claim is merely a software to calculate a lowest price for customers including shipping prices determinations according to USA zip-code for shipping to because according to the above Chinese restaurant well-known example, ordering together would save shipping fees comparing to making separate orders.

B. As to dependent claim 3: Pallakoff suggests a system to receiving different orders from different parties, and manages those information (see Pallakoff's Internet configuration, Fig. 1 refs. 14a – 14d).

C. As to dependent claims 4-5: Pallakoff discloses an access control component (including sending messages/notices to sellers, and buyers/users, see Pallakoff, Fig. 1 ref. 1, Fig.3 refs. 37-38).

D. As to dependent claim 6: Pallakoff's system inherently comprises a terms and conditions component to manage agreements between buyers and sellers (see Pallakoff, the abstract's "conditional offer", and col. 1 line 55 – 58, and col. 12 lines 5-10 "term").

E. As to dependent claims 7, 12-13: Pallakoff inherently teaches a blanket pricing component to manage agreements between buyers and sellers as to product prices, managing accounts (i.e., "maintaining a deposit account with the system operator", and providing decision supports to buyers/sellers - see Pallakoff, Fig. 1 ref. 13 – the "System Controller 13" performs above claimed functions).

F. As to dependent claim 11: Pallakoff discloses that a system controller 13 comprises a RFP component operable to manage product requests (see Pallakoff, Fig.1).

G. As to dependent claims 14, 19: Pallakoff discloses a system with terminal 12 and

terminal 14 representing a seller agent, and a buyer agent; Pallakoff inherently teaches

that his system creates an order a buyer according to a buyer's request (see Pallakoff, col.

11 lines 44-46).

H. As to dependent claim 16: Pallakoff inherently teaches that a system controller 93

gives detail information of a sellers in an offer (see Pallakoff, Fig.1 ref. 93, and Fig.3

ref.37).

I. As to independent claim 43: Pallakoff discloses a system for volume pricing,

comprising:

    - a server configured to receive orders for a product from a plurality of different

buyers via at least one remote computer system, the server comprising "physical

components":

-        a processor;

-        a memory coupled to the processor; and

-        a network interface coupled to the processor for transmitting and receiving

data with a remote computer system (see Pallakoff, Fig.1).

    Pallakoff does not expressly disclose "specific contents" of a memory; however,

the examiner respectfully submits that Pallakoff sufficiently provides structural

components to build up the claimed system.

    It would have been obvious to one of ordinary skill in the art at the time of

invention to implement Pallakoff's structure with a suggestion of Shavit et al. to contain

a first price schedule and a second price schedule due to these schedules are merely

"written material" that do not significantly change the claimed structure of Pallakoff (also

note that a common practice of "share-shipping" has been widely used as above Shavit et al.'s practice).

J. As to dependent claims 44-45: Pallakoff obviously suggests that a first and a second price are determined according to a quantity of product ordered, or depending on when an order is placed (see Pallakoff, Fig.3 ref. 32, the abstract, and claims 1, 8) – also note that this claimed limitation is non-functional written material for a memory component.

K. As to dependent claim 46: Pallakoff discloses a system wherein different buyers access to view detailed product information (e.g., the first and second price schedules) via remote computes (see Pallakoff, Fig.9 ref. 96) – moreover, it is common sense to display detailed materials/data because a user always want to know detailed information before making an order of a product.

L. As to dependent claim 47: Pallakoff discloses a system controller 13 comprising a memory storage to receiving orders wherein a server being configured to limit a period during which orders for the product are accepted to an open session period – a non-functional detail description material: a limited time requirement (see Pallakoff, Fig.3 ref. 32, and claims 1, 8).

M As to dependent claim 2: This claim is merely directed to a system as in claim 1, comprising a product catalog – the examiner respectfully submits that this claimed feature is a well-known practice in advertising about what are selling by a store/site.

Pallakoff discloses a system to order a variety of products (see Pallakoff, Fig.1 refs. 12a-12x).

Pallakoff does not disclose a catalog of products in his system.

However, a list of products (a catalog) would have been available for customers to make selections, and knowing that product's availability, and price .etc., those information would have been obvious to one of ordinary skill in the art at the time of invention as "catalog" means containing related information of provided products for related references.

N. As to dependent claims 8-10: Pallakoff discloses a system comprising a product database (system controller 13 consists of server hardware running database software).

He does not disclose a relationships component to manage relationships between products (a byproduct relationship – e.g., a monitor screen and a desk-top computer system, or a NEC monitor screen 17" versus a NEC monitor screen 20")

However, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Pallakoff's structure to use a relational database instead of a regular database for "linking" between products because a relational database is merely "written material"/database that do not significantly change Pallakoff's system.

0. As to dependent claims 15, and 18: Pallakoff does not disclose that his system uses customer's historical data to determine a price.

However, it was old and well-known that customers' historical data/profiles have been widely used for selling products (e.g., a Circuit City store uses customer's phone number to trace a consumer's history, and Best Buy stores give discount coupons (a different price) to past customers in their database) – a motivation for using customer's profile for determining a price is to encourage regular visitors for doing more business with those stores (note that claim 18's "to assist at least one of the plurality of buyers in

finding a best buy for at least one of a plurality of products" is merely an intent of use of a "system" claim – it is not a limitation).

It would have been obvious to one of ordinary skill in the art at the time of invention to implement Pallakoff''s system for using customer's historical data to determine a pricing strategy of a product with respect to at least one of the plurality of buyers.

P. As to dependent claim 17: Pallakoff suggests that his system could provide information of a production schedule (e.g., delivery time).

The motivation is that detail information about a production schedule has been informed to buyers for anticipation/preparation of their own events.

Q. As to dependent claims 73, and 76: The rationales and references for claim 1 are incorporated.

The examiner respectfully submits that claimed limitation of: "*an order from at least one of the plurality of buyers is independent from other order received*" is interpreted as: "an order from a buyer is independent from others" – this has been well-known; e.g., S/H fee to a same address for a BIG box/package (from a store) with different sub-orders from several employees in an office

The motivation is that detail information about each particular order has been listed to different buyers for clear details of charges on each item; a S/H cost can be easily divided among ordered people later on.

R. As to dependent claims 70-72, and 74-75: The examiner respectfully submits that these claims are directed about facilitating shipping aggregation for buyers, i.e., creating savings when order.

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Pallakoff''s system and Shavit et al.'s idea to suggest a system to calculate/charge a lower price for customers (including shipping price for that order – usually an order's shipping cost is calculated from weight/size of that order, it is well-known to include many different orders in one package because those orders go to a destination for the advantage of to avoid standard charges for separate orders; especially many employees of the same office order different products in a list from that same office).

Conclusion

10.   Pending claims are unpatentable;

11.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose telephone number is 571-272-6759. The examiner can normally be reached on 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THOMAS G. BLACK can be reached on 571-272-6956. The Rightfax number for the organization where this application is assigned is 571-273-6956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Please provide support, with page and line numbers, for any amended or new

claim in an effort to help advance prosecution; otherwise any new claim language that

is introduced in an amended or new claim may be considered as new matter, especially

if the Application is a Jumbo Application.

CUONG H. NGUYEN
Primary Examiner
Art Unit 3661